

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Synergy One Lending, Inc.

Serial No. 88063190

Kit M. Stetina of Stetina Brunda Garred & Brucker
for Synergy One Lending, Inc.

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Before Wellington, Lykos and Greenbaum,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Synergy One Lending, Inc. (“Applicant”) seeks to register the mark
RETIREMENT FUNDING SOLUTIONS in standard characters on the Principal
Register (RETIREMENT FUNDING disclaimed) for “Financial services, namely,
mortgage lending services” in International Class 36.¹

¹ Application Serial No. 88063190, filed August 2, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce. In response to the first Office action refusing registration, Applicant entered a voluntary disclaimer of the wording RETIREMENT FUNDING. See May 23, 2019 Response to Office Action.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of Applicant's identified services. The appeal is fully briefed.² For the reasons set forth below, we affirm the refusal to register.

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act prohibits registration of a mark on the Principal Register that, when used in connection with an applicant's services, is merely descriptive of them. 15 U.S.C. § 1052(e)(1).³ "A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). By contrast, a mark is suggestive if it "requires imagination,

² The Examining Attorney's motion to accept her late-filed brief "[d]ue to an internal miscommunication regarding the filing deadline," 6 TTABVUE 2-3, is granted. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TBMP") § 1203.02(d) (2020) ("Extension of Time for Filing Brief").

In addition, we note Applicant's dictionary definitions of "fund" from the online version of Merriam-Webster and Dictionary.com submitted for the first time with its main brief. Applicant's Brief, Exhibits A and B, 4 TTABVUE 12-15. As a general proposition, evidence not part of the record submitted at the briefing stage is untimely. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). However, in this particular case, because the Examining Attorney failed to object to the submission in her appeal brief and because the evidence consists of dictionary entries, the Board has considered this evidence. *See* TBMP § 1207.03 ("Evidence Considered Due to Actions of Nonoffering Party").

³ "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . ."

thought, and perception to arrive at the qualities or characteristics of the [services].” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Suggestive marks, unlike merely descriptive terms, are registrable on the Principal Register without proof of acquired distinctiveness. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004).

The determination of whether a mark is merely descriptive must be made in relation to the services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those services, and the possible significance that the mark would have to the average purchaser of the services in the marketplace. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987). In other words, the question is not whether someone presented only with the mark could guess the services listed in the identification. Rather, the question is whether someone who knows what the services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys,” *In re Bayer*, 82 USPQ2d at 1831, as well as “labels, packages, or in

advertising material directed to the [services].” *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). It may also be obtained from websites and publications, and, in the case of a use-based application, an applicant’s own specimen of use and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001). In this particular case, the involved application has been filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), meaning that Applicant has yet to claim use in the United States. Nonetheless, the Examining Attorney is not precluded from introducing excerpts from Applicant’s own materials, website, or news articles as evidence of public perception of the mark. *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006) (examining attorney may introduce evidence that applicant’s own literature supports descriptiveness of term despite the fact that application based on intent-to-use under Trademark Act Section 1(b); fact that applicant has filed an intent-to-use application does not limit the examining attorney’s evidentiary options or shield an applicant from producing evidence that it may have in its possession).

Notwithstanding Applicant’s voluntary disclaimer of RETIREMENT FUNDING, the issue before the Board is whether Applicant’s mark RETIREMENT FUNDING SOLUTIONS, as a whole, merely describes the identified services.

Applicant, citing examples from Section 1209.01(b) of THE TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) involving different marks held to be merely

descriptive,⁴ argues that RETIREMENT FUNDING SOLUTIONS does not immediately convey any aspect of “Financial services, namely, mortgage lending services.” Applicant contends that mortgage lending is not a recognized “retirement *funding* solution.”⁵ As Applicant maintains, “taking out a mortgage, even a reverse mortgage, is not ‘funding’ anything according to the ordinary meaning of the word, which is to provide funds for something. ... When a retiree takes out a reverse mortgage, she is not providing funds for retirement. Rather, she is receiving funds from the reverse mortgage lender.”⁶ In support, Applicant points to two dictionary entries defining “fund” as “to provide funds for” or “to allocate or provide funds (a program, project, etc.).”⁷ In Applicant’s view, the Examining Attorney impermissibly “equates ‘retirement funding’ with receiving money during retirement, effectively reading the word ‘funding’ out of the Proposed Mark.”⁸

With regard to the examples of marks found to be merely descriptive listed in the TMEP (*see n. 4*), we remind Applicant that “[t]he great variation in facts from case to case prevents the formulation of specific rules for specific fact situations. Each case

⁴ Some examples Applicant cites to include NOPALEA held merely descriptive of dietary and nutritional supplements, APPLE PIE held merely descriptive of potpourri, and BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services. Applicant’s Brief, pp. 5-6; 4 TTABVUE 6-7.

⁵ Applicant’s Brief, p. 6; 4 TTABVUE 7 (emphasis in original).

⁶ *Id.*

⁷ Applicant’s Brief, Exhibits A and B, definition of “fund” from merriam-webster.com and dictionary.com.

⁸ Applicant’s Brief, p. 6; 4 TTABVUE 7.

must be decided on its own merits.” TMEP § 1209.01(b) (citing *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985) and *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977)).

Applicant’s argument that the word FUNDING as used in the phrase RETIREMENT FUNDING in its mark cannot be merely descriptive because the consumer does not provide funds for retirement but rather receives fund from the reverse mortgage lender misses the point. Mere descriptiveness is analyzed vis-à-vis consumer perception of the entire mark as it relates to the identified services. RETIREMENT FUNDING functions as an adjectival phrase modifying the plural noun SOLUTIONS in Applicant’s mark. When considered in relation to Applicant’s “[f]inancial services, namely, mortgage lending services,” prospective consumers will immediately perceive or understand Applicant’s mark RETIREMENT FUNDING SOLUTIONS as connoting methods, such as reverse mortgages, to help finance or fund retirement living.

“Retirement funding” is a commonly used phrase in the financial services industry to designate various investment vehicles for funding an individual’s retirement. *See, e.g., Helping You Achieve Your Goals With Retirement Funding*, FARM BUREAU FINANCIAL SERVICES, www.fbfs.com/investments/retirementfunding (accessed Nov. 24, 2018) (“With **retirement funding** options that include annuities, mutual funds, IRA’s and more, Farm Bureau can help you understand your options and plan to achieve your retirement goals.”).⁹ Devising income streams and funding

⁹ November 24, 2018 Office Action, p. 14 (emphasis added).

Record citations to the prosecution history are to the USPTO’s Trademark Status and Document Retrieval (“TSDR”) docketing system.

sources for retirement has become challenging, given the recent decline in private employer-sponsored pension plans and age eligibility requirements for Social Security benefits. See Darwin Bayston, *How to Embrace the New Era of 'DIY' Retirement Funding*, LISA LIFE INSURANCE SETTLEMENT ASSOCIATION, www.lisa.org/life-policy-owners/consumer-blog (June 13, 2018) (“In previous generations, it was common for an American to land a job at a stable company, work for the same employer for decades, then retire one day with the proverbial gold watch and nice pension to supplement their monthly Social Security income.”).¹⁰ To solve the problem, many retirees are forced to consider novel ways of funding their retirements. See Lisa Smith, *Five Sources of Income for your Retirement*, INVESTOPEDIA, www.investopedia.com (June 1, 2018) (“So how exactly will you turn your nest egg into a steady flow of cash during your retirement years? These concrete strategies could help.”).¹¹ Funding sources may include mortgage lending services such as reverse mortgage loans which are specifically geared towards retirement aged individuals. See Steve Randall, *55places, Retirement Funding Solutions Launch Mortgage Business*, MPA MORTGAGE PROFESSIONAL AMERICA, www.mpamag.com (May 23, 2019) (discussing the partnership between Applicant and 55places, a retirement community, to provide mortgages to senior homebuyers age 62 and above, with Applicant providing Home Equity Conversion Mortgages (“HECM”)).¹² In

¹⁰ *Id.* at 36-37.

¹¹ *Id.* at 2-7.

¹² June 12, 2019 Office Action, pp. 21-22.

ordinary lexicon, the word “solutions” is defined as “an answer to a problem.” THE MERRIAM-WEBSTER DICTIONARY, www.merriam-webster.com (accessed Nov. 24, 2018).¹³ And in the financial services industry, it is not uncommon for mortgage lenders to promote the benefits of reverse mortgages to retirees as a “solution” or “retirement funding solution” to the dilemma of how to fund retirement:

Does Your Mortgage Retire With You? AMERICAN FINANCING, www.americanfinancing.net (accessed June 12, 2019): “Financial **solutions** ... [H]omeowners over the age of 62 can take out a reverse mortgage, a home loan designed to cover a portion of home equity into case.”¹⁴

Sara Cornwall, Reverse Mortgage Advisor, www.saracornwell.com/reverse-mortgage-and-retirement (accessed June 12, 2019): “For the past quarter century older Americans have easily managed to retire on three things: company pensions, Social Security, and personal savings. But with a rocky economy not long behind us – and still unsteady in many areas – baby boomers are being forced to take a second look at their retirement portfolios. ... For individuals and married couples 62 and older, reverse mortgage is something that should be considered when seeking **retirement funding solutions**.”¹⁵

Jessica Guerin, *Finance of America Rebrands As Retirement Solutions Provider*, HOUSING WIRE housingwire.com (accessed Nov. 24, 2018) “Reverse Mortgage Lender Finance of America Reverse announced it is rebranding as a provider of retirement **solutions** dedicated to helping people ‘get to work on retirement. ... It appears FAR’s strategy is to reach beyond the HECM, coupling its innovation in the proprietary reverse mortgage market with a move to embrace alternative solutions

¹³ November 24, 2018 Office Action, pp. 16-22.

¹⁴ June 12, 2019 Office Action, pp. 33-36.

¹⁵ *Id.* at 29-31.

designed to help seniors build a more comfortable retirement.”¹⁶

Indeed, Applicant’s own website touts the benefits of using reverse mortgages as a financial planning tool for retirement:

https://rfslend.com/about-us/ 06/12/2019 02:21:52 PM

RETIREMENT FUNDING SOLUTIONS
A Mutual of Omaha Bank Company

Mutual of Omaha Bank
Member FDIC

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We Are Here To Serve You

Retirement Funding Solutions was created to address and solve for one of the most significant challenges facing the Baby Boomer Generation today...*Being Financially Prepared for Your Retirement Years.*

RFS is committed to educating Retirees and their families on the value of a product that has been created by the US Government during President Reagan’s term in Office. The Home Equity Conversion Mortgage (HECM) was designed to utilize the equity in your home as a means to assist a peaceful and secure transition to one’s retirement years. Many Financial Advisors are now realizing the value of this product as one of several overall financial planning tools.

The TEAM at RFS is committed to you, and are here to assist you on your timeline...not ours.

Our Commitment to you is that the educational process will be based upon an honest, ethical and open dialogue. RFS’ goal is to integrate our dialogue into your circle of trusted advisors, whether those be family or a team of financial professionals.

Mission Statement

To build a team of Professionals who consistently deliver a range of financial solutions that can improve your retirement years.

Core Values

- Integrity
- Loyalty
- Diligence
- Compassion

For Consumers

Funding America’s Retirement is exactly what we had in mind, with a Reverse Mortgage we will assist you in unlocking your equity so you can use it now.

[More Information](#)

For Advisors

The Reverse Mortgage- a needs based “product of last resort” or a powerful component in an overall and more comprehensive retirement plan?

[More Information](#)

For Real Estate Professionals

Over 350,000 seniors will purchase a new home for retirement this year, HECM For Purchase is an excellent tool to capture this growing market.

[More Information](#)

For Our Partners

Interested in helping your senior clients live a fulfilling retirement, visit our partner website to see how reverse mortgages can work for your clients.

[More Information](#)

As further “persuasive evidence,” see *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978), the Examining Attorney made of record third-party registrations disclaiming the term SOLUTIONS for mortgage lending services.¹⁷ “Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to [the services].” *Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). This evidence lends further support to the determination that “solutions” is a term of art in the mortgage lending industry.

Based on the foregoing evidence, the combination of RETIRMENT FUNDING SOLUTIONS, when considered as a whole, merely describes the purpose of Applicant’s mortgage lending services of providing answers to the conundrum of retirement funding.

Applicant counters that its proposed mark is suggestive because it requires imagination on the part of consumers to make a connection to the identified services. Given the nature of the services, we are skeptical that prospective consumers would attribute any other meanings to the mark RETIREMENT FUNDING SOLUTIONS. Again, the question of whether a proposed mark is merely descriptive is not determined by asking whether one can guess, from the mark itself, what the services are, but rather by asking, when the mark is seen on or in connection with the services,

¹⁷ See Registration Nos. 5085886, 4679694, 3879879, and 3573588 submitted with June 12, 2019 Office Action.

whether it immediately conveys information about their nature. *In re MBNA Am. Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); *In re Tower Tech*, 64 USPQ2d at 1316-17; *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). No imagination or thought is required by prospective consumers to discern the nature of Applicant's services. To the contrary, to purchasers encountering Applicant's services, Applicant's proposed mark immediately conveys, without conjecture or speculation, the purpose of the services, namely a solution for retirement funding.

In sum, we find Applicant's standard character mark RETIREMENT FUNDING SOLUTIONS to be merely descriptive of the identified services and therefore ineligible for registration on the Principal Register in the absence of a showing of acquired distinctiveness. As explained in the seminal case of *In re Abcor Dev. Corp.*, 200 USPQ at 217:

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular [services]; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

Decision: The descriptiveness refusal to register Applicant's mark under Section 2(e)(1) of the Trademark Act is affirmed.